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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,966	06/02/2000	Kiyofumi Tsuruta	1614.1057	5257

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EXAMINER

BLACKWELL, JAMES H

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/584,966

Applicant(s)

TSURUTA, KIYOFUMI

Examiner

James H Blackwell

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-5, 9 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6, 7, 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-5, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Zdybel, Jr. et al. (hereinafter Zdybel, U.S. Patent No. 5,486,686).

Regarding independent Claim 1 (and similarly independent Claims 4, and 9), Zdybel teaches printing unfiltered or filtered (i.e., complete or partial, uncompressed or compressed) machine readable digital representations of electronic documents and human readable renderings of them on the same recording media using the same printing process (Col. 4, lines 45-51; Figs. 3-4; compare to Claim 1 (and similarly Claims 4, and 9), ***"A method of producing printed matter containing a direct reading material and an additional material related to the direct-reading material by an information processing apparatus, the direct-reading material comprising text and pictures, and the additional material comprising text, sound, and images related to the direct-reading material, the method comprising:"***). Zdybel also teaches that for integrating a digital, machine readable representation (101) of the electronic document (32) with the human readable rendering of it, the bit-level digital data content of the ASCII, DDL or PDL encodings of all or selected portions of the electronic document (32) is encoded at (105) to convert it into "glyph encodings"

(encodings representing distinctive markings having at least two distinguishable, machine readable states--viz., a true ("1") state and a false ("0") state). These glyph encodings are then merged into the electronic document description file for the electronic document (32) to cause the glyphs to be printed on the hardcopy output document (102) at one or more selected locations (Col. 8, lines 39-50; compare to Claim 1 (and similarly Claims 4, and 9), "**... converting primary data of the additional material into secondary data in the form of codes for high-density display**").

Zdybel also teaches that the glyphs may be printed at various locations on the hardcopy document (102). For instance, one or more fields may be set aside in the top, bottom, right-hand or left-hand margins of the document (102) for the printing of such glyphs.

Alternatively, as shown in Figs. 3 and 4, the glyphs may be printed in machine identifiable glyph frames which are fully or partially confined within the margins of the human readable field of the document (102) or fully outside those margins (Col. 9, lines 13-21; compare to Claim 1 (and similarly Claims 4, and 9), "**... performing an allocating operation for the direct-reading material and the additional material in accordance with a type space corresponding to the secondary data**"). Zdybel also

teaches that for example, the glyph encoded data that is embedded in the hardcopy document (102) may include one or more of the following: machine readable descriptions of the data points for structured graphics as at (131), machine readable descriptions of the algorithms utilized for performing computations for spreadsheets and the like as at (132), machine readable descriptions of hypertext pointer values as at (133), machine readable descriptions of some or all of the structural characteristics of

the electronic source document as at (134), machine readable descriptions of the document editor used to prepare the source document (32), as at (135), machine readable descriptions of the file name and storage location of the electronic source document (32), as at (136), and machine readable descriptions of audit-trail data for the electronic source document (32), as at (137) (Col. 10, lines 13-27; compare to Claim 1 (and similarly Claims 4, and 9), “... ***the primary data of the additional material converted into the secondary data in the form of codes for high-density display comprise data from which information content is obtained directly without accessing a separate storage location***”).

Regarding dependent Claim 2 (and similarly dependent Claim 5), Zdybel teaches that if all of the digital data contained by the electronic document (32) is printed in digital data form on the hardcopy (102), the electronic document (32) can be recovered merely by employing the input scanner (12) for scanning the glyph encoded data to recover the data that affects the appearance of the document, as at (121), as well as the data that is not inferable from the appearance of the document, as at (122) (Col. 9, lines 46-53; compare to Claim 2 (and similarly Claim 5), “... ***said performing an allocating operation comprises linking the direct-reading material designated by a user and the related additional material***”).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-2, 4-5, and 9 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
03/11/04



**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**